REMARKS

Claims 1-12 and 14-27 are pending. Claims 10 and 14 have been amended. Claim 13 was canceled without prejudice.

Claim Rejections – 35 U.S.C. §103

The Patent Office rejected claims 1-2, 4 and 8-9 under 35 U.S.C. §103(a) as being unpatentable over Sawdy et al., U.S. Patent No. 6,351,831 (Sawdy) in view of Rauscher, U.S. Patent No. 6,874,100 (Rauscher) and further in view of Cruyningen, U.S. Publication 2002/0019897 (Cruyningen).

Applicant respectfully traverses. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). Applicant respectfully submits claim 1 recites limitations which have not been disclosed, taught or suggested by Sawdy, Rauscher and Cruyningen. For example, claim 1 recites a first storage array controller module which provides an availability signal to the second storage array controller module, and if the second storage array controller module does not receive a signal from the first storage array controller module within a given period of time, the second storage array controller module asserts control over the array of storage devices.

Sawdy, Raushcher and Cruyningen fail to disclose a first storage array controller module which provides an availability signal to the second storage array controller module, and if the second storage array controller module does not receive a signal from the first storage array controller module within a given period of time, the second storage array controller module asserts control over the array of storage devices. The Patent Office cites column 2, lines 57-68 of Rauscher for support of its assertion. However, Rauscher, along with Sawdy and Cruyningen, fail to disclose if the second storage array controller module does not receive a signal from the first storage array controller module within a given period of time, the second storage array controller module asserts control

over the array of storage devices. Rauscher merely mentions a heartbeat signal with no time limitation. Additionally, Rauscher further states the problems associated with the heartbeat signal which would motivate others not to operate with a heartbeat signal. (Rauscher, Column 2, Lines 62-67). Consequently, elements of claim 1 have not been disclosed, taught or suggested by Sawdy, Rauscher and Cruyningen, individually or in combination. Under *in re Ryoka*, a *prima facie* case of obviousness does not exist for claim 1. Claims 2, 4, 8 and 9 are believed allowable due to their dependence upon allowable claim 1.

The Patent Office rejected claim 3 under 35 U.S.C. §103(a) as being unpatentable over Sawdy et al., U.S. Patent No. 6,351,831 (Sawdy) in view of Rauscher, U.S. Patent No. 6,874,100 (Rauscher) in view of Cruyningen, U.S. Publication 2002/0019897 (Cruyningen) and further in view of Brocade (Quick loop data sheet).

Applicant respectfully traverses. It is contended that all of the claims rejected under this section depend on independent claim 1, which is non-anticipatory and non-obvious based on the rationale above. Thus, dependent claim 3 (which depends on independent claim 1) should be allowed.

The Patent Office rejected claims 5-7 under 35 U.S.C. §103(a) as being unpatentable over Sawdy et al., U.S. Patent No. 6,351,831 (Sawdy) in view of Rauscher, U.S. Patent No. 6,874,100 (Rauscher) in view of Cruyningen, U.S. Publication 2002/0019897 (Cruyningen) and further in view of Deng, U.S. Patent 6,937,608 (Deng).

Applicant respectfully traverses. It is contended that all of the claims rejected under this section depend on independent claim 1, which is non-anticipatory and non-obvious based on the rationale above. Thus, dependent claims 5-7 (which depend on independent claim 1) should be allowed.

The Patent Office rejected claims 10-12, 15-18 and 20 under 35 U.S.C. §103(a) as being unpatentable over Sawdy et al., U.S. Patent No. 6,351,831 (Sawdy) in view of

Rauscher, U.S. Patent No. 6,874,100 (Rauscher) in view of Cruyningen, U.S. Publication 2002/0019897 (Cruyningen) and further in view of Workman et al., U.S. Publication 2004/0068591 (Workman). The Patent Office rejected claims 19 and 21 under 35 U.S.C. §103(a) as being unpatentable over Sawdy et al., U.S. Patent No. 6,351,831 (Sawdy) in view of Rauscher, U.S. Patent No. 6,874,100 (Rauscher) in view of Cruyningen, U.S. Publication 2002/0019897 (Cruyningen) in view of Workman et al., U.S. Publication 2004/0068591 (Workman) and further in view of Ito et al., U.S. Publication 2003/0014600 (Ito). The Patent Office rejected claims 13-14 and 22-27 under 35 U.S.C. §103(a) as being unpatentable over Sawdy et al., U.S. Patent No. 6,351,831 (Sawdy) in view of Rauscher, U.S. Patent No. 6,874,100 (Rauscher) in view of Cruyningen, U.S. Publication 2002/0019897 (Cruyningen) in view of Workman et al., U.S. Publication 2004/0068591 (Workman) and further in view of Jantz, U.S. Patent 5,944,838 (Jantz).

Applicant respectfully traverses each rejection. Claim 10 has been amended to include the limitations of claim 13. Applicant respectfully submits claims 10-12 and 14-22 are novel and nonobvious. The Patent Office has combined no less than five references to meet each limitation of claims 10 and 22 and has failed to provide any support for combining each of the five references. Rather, the Patent Office is impermissibly selecting features from five references in a combination set forth by the present application and stating the combination is obvious. Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). Thus, the Examiner may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention.

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the

desirability of the modification. .... It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) *quoting In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

> The Dean statement is of the type that gives only general guidance and is not at all specific as to the particular form of the claimed invention and how to achieve it. Such a suggestion may make an approach "obvious to try" but it does not make the invention obvious. .... We recognize that given the teaching in appellant's specification regarding incorporation of the gene into the chromosome and utilizing the bacteria in the plant environment, one can theoretically explain the technological rationale for the claimed invention using selected teaching from the references. This approach, however, has been criticized by our reviewing court as hindsight reconstruction. *Ex parte Obukowicz* at 1065.

Since obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination, claims 10-12 and 14-27 should be allowed.

CONCLUSION

In light of the forgoing, reconsideration and allowance of the claims is earnestly solicited.

Respectfully submitted,
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